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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,083	06/27/2000	Steven M. Bessette	45112-077	4331

7590 12/10/2001

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EXAMINER

FLOOD, MICHELE C

ART UNIT PAPER NUMBER

1651


DATE MAILED: 12/10/2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/604,083	Applicant(s) Bessette
Examiner Michele Flood	Art Unit 1651



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on Oct 15, 2001.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1, 2, and 8-11 is/are pending in the application.
- 4a) Of the above, claim(s) 9-11 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1, 2, and 8 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
a) All b) Some* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) Notice of References Cited (PTO-892) 18) Interview Summary (PTO-413) Paper No(s)
- 16) Notice of Draftsperson's Patent Drawing Review (PTO 948) 19) Notice of Informal Patent Application (PTO-152)
- 17) Information Disclosure Statement(s) (PTO 1449) Paper No(s) 20) Other

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DETAILED ACTION

Acknowledgment is made of the receipt and entry of the amendments filed on October 15, 2001. Acknowledgment is made of Applicant's cancellation of Claims 3-7, and the claims are withdrawn from further consideration by the Examiner. Acknowledgment is made of newly submitted Claims 8-11.

Newly submitted claims 9-11 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The claims are drawn to compositions comprising ingredients other than the elected species, namely phenyl ethyl alcohol.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 9-11 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 1, 2 and 8 are under examination.

The claims have been examined, insofar as, they read on the elected species, namely, phenyl ethyl alcohol.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 2 as amended are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 2 are rendered confusing by misplaced punctuation, which makes the subject matter to which Applicant intends to direct the invention unclear. For instance, it is uncertain as to what compound Applicant refers to which is miticidally effective against mold mites, in Claim 1. Is the compound which is miticidally effective against mold mites the acceptable carrier or one of the essential oils referred to in the Markush group? The lack of clarity renders the claim indefinite.

Claim 2 recites the limitation "wherein the plant essential oil is miticidally effective" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 2 is generally indefinite. The claim language is so confusing that it is uncertain as to the subject matter Applicant intends to direct the invention. The claim is so replete with grammatical errors and incomprehensible, as to preclude a reasonable search by the examiner. The claim should be appropriately amended to do so.

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Please note that the language of a claim must make it clear what subject matter the claim encompasses to adequately delineate its "metes and bounds". See, e.g., the following decisions: In re Hammack, 427 F.2d. 1378, 1382, 166 USPQ 204, 208 (CCPA 1970); In re Venezia 530 F.2d. 956, 958, 189 USPQ 149, 151 (CCPA 1976); In re Goffe, 526 F.2d. 1393, 1397, 188 USPQ 131, 135 (CCPA 1975); In re Watson, 517 F.2d. 465, 477, 186 USPQ 11, 20 (CCPA 1975); In re Knowlton 481 F.2d. 1357, 1366, 178 USPQ 486, 492 (CCPA 1973). The courts have also indicated that before claimed subject matter can properly be compared to the prior art, it is essential to know what the claims do in fact cover. See, e.g., the following decisions: In re Steele, 305 F.2d. 859, 134 USPQ 292 (CCPA 1962); In re Moore 439 F.2d. 1232, 169 USPQ 236 (CCPA 1969); In re Merat, 519 F.2d. 1390, 186 USPQ 471 (CCPA 1975).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1 and 2 as amended and newly submitted Claim 8 remain/is rejected under

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under 35 U.S.C. 102(b) as being anticipated by (N, JP 04059703) or (O, JP 04164072A). The rejection stands for the reasons set forth in the previous Office action and set forth below.

For the sake of expeditious prosecution, Claim 1 has been interpreted as being directed to a composition for the control of mold mites comprising, in admixture with an acceptable carrier, at least one compound selected from the group of phenyl ethyl alcohol, wherein the compound is miticidally effective against mold mites. Applicant further claims a pesticidal composition for the control of mold mites comprising 2-phenyl alcohol in admixture with an acceptable carrier.

Applicant argues that the teachings of JP 04059703 does not disclose each and every element of the invention, as presently recited in the claims against mold; and therefore, Applicant concludes that the JP 04059703 fails to anticipate the claimed subject matter. However, this is not persuasive because JP 04059703 teaches a miticidal composition comprising carvone, p-methyl acetophenone, 2-phenylethyl alcohol, (iso)thymol, methyl benzoate and/or methyl salicylate in the form of emulsions, dispersions, oil preparations, dusts, tablets or propellants. It is noted that the reference does not expressly teach that the composition can be used in the manner instantly claimed, however, the intended use of the claimed composition does not patentably distinguish the composition, per se, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting.

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With regard to Claim 2, as phenyl ethyl alcohol is a compound comprising a monocyclic, carbocyclic ring structure having a six members and having substituted by at least one oxygenated functional moiety, the referenced composition claims the subject matter.

Thus, the claimed functional effect for the control of mold mites is inherent to the referenced composition.

The reference anticipates the claimed subject matter.

Claims 1-2 as amended and newly submitted Claim 8 remain/is rejected under 35 U.S.C. 102(b) as being anticipated by JP 04164072A (O).

Applicant argues that JP 04164072A merely discloses d,1-4-tert-butyl-alpha-phenylethylalcohol as a control for mites, and that the reference does not teach phenyl ethyl alcohol as the active miticide but is directed to the synthesis of the referenced composition. However, this is not persuasive because JP 04164072 clearly teaches a miticide comprising an oxypyrimidine derivative, which was prepared by dissolving d,1-4-tert-butyl-alpha-phenylethylalcohol in N, -dimethylformamide and sodium hydride to obtain d,1,5-chloro-6-ethyl-1(1-4-tert-butylphenyl)ethoxy)pyrimidine, and the synthesis thereof. As the referenced compound comprising the miticidal composition taught by JP 04164072A has at least one compound comprising a monocyclic carbocyclic ring having six members and substituted by at least one oxygenated or hydroxyl functional moiety, the reference anticipates the claimed subject matter. It is noted that the reference does not teach that the composition can be used in the manner instantly

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claimed, however, the intended use of the claimed composition does not patentably distinguish the composition, per se, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting.

The reference anticipates the claimed subject matter.

Claims 1-2 as amended and newly submitted Claim 8 remain/is rejected under 35 U.S.C. 102(e) as being anticipated by Zocchi et al. (A, US Patent 5,719,114) or Lover et al. (D). The rejection stands for the reasons set forth in the previous Office action and set forth below.

Applicant argues that neither Zocchi (A) nor Lover anticipate the claimed subject matter because Zochhi merely discloses a microemulsion cleaning composition comprising phenyl ethyl alcohol against dust mites and that Lover discloses a toxic composition against lice and their ova, and scab mites. However, this is not persuasive because Zocchi, in Column 18, lines 25-60, clearly teaches a contact pesticidal for the control of mites comprising phenyl ethyl alcohol, and Lover clearly teaches a contact composition for the control of mites, wherein the composition comprises 2-phenylethanol (see Column 4, lines 47-60), and an acceptable carrier. It would appear that Applicant argues, since neither Zochhi nor Lover expressly teach that the referenced compositions are a composition for the control of mold mites, that the references fail to anticipate

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the claimed subject matter. However, as the genus anticipates the species, and as both Zocchi and Lover teach a composition comprising phenyl ethyl alcohol with miticidal activity, the referenced compositions inherently are a composition for the control of mold mites.

With regard to Claim 2, as phenyl ethyl alcohol is a compound comprising a monocyclic, carbocyclic ring structure having a six members and having substituted by at least one oxygenated functional moiety, the referenced composition claims the subject matter.

Applicant is asked to review *In re Hack*, 245 F.2d 246, 248, 114 USPQ 161, 163 (CCPA 1957). “When the claim recites using an old composition or structure and the “use” is directed to a result or property of that composition or structure, then the claim is anticipated” (MPEP 2100 pp. 2113).

The references anticipate the claimed the subject matter.

Claims 1 and Claim 2 as amended and newly submitted Claim 8 remain/is rejected under under 35 U.S.C. 102(e) as being anticipated by Zocchi et al. (B, US Patent 5,985,814) or Zocchi et al. (C, US Patent 6,087,402) or Bessette et al. (E). The rejection stands for the reasons set forth in the previous Office action and set forth below.

Applicant argues that Zocchi et al. (B, US Patent 5,985,814) does not disclose Applicant's invention as recited in the claims. Applicant further argues that Zocchi ('814) discloses phenyl ethyl alcohols as a member of a long list of other plant essentials which may be one of many substitutes for perfume and secondly may have acaricidal activity. However, this is not persuasive

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because Zocchi (B, '814) teaches a miticidal, carpet-cleaning composition comprising plant essential oils as an acaricidal agent (see Column 6, lines 33-60), and an acceptable carrier. The referenced composition taught by Zocchi is in the form of a contact liquid or hydrocarbon propellant (see Column 4, lines 51-63). In Column 11, lines 35-67 to Column 12, lines 1-32, Zocchi teaches that the acaricidal agents comprise a monocyclic, carbocyclic ring structure having six-members and substituted by at least one oxygenated or hydroxyl functional moiety. See Claims 1-16.

With regard to Zocchi (C, '402), Applicant argues that Zocchi ('402) fails to anticipate the claimed invention because Zocchi ('402) teaches a composition against dust mite, instead of a composition against mold mites. However, this is not persuasive because Zocchi (402) expressly teaches a foam composition for killing dust mites comprising an acaricidal agent and water. The acaricidal agents taught by Zocchi are essential plant oils, such as phenyl ethyl alcohol. See Column 5, lines 6-17. See Claims 1-5. Bessette teaches a pesticide comprising plant essential oils and an acceptable carrier, wherein the plant essential oil comprises a six member carbon ring and having substituted thereon at least one oxygenated functional group (see Column 3, lines 41-47).

With regard to Bessette, Applicant argue that Bessette teaches methods for controlling insects using pesticidal mixtures. Applicant further argues that Bessette does not disclose the specific miticidal compositions, as presently recited in the claims against mold mites. However, this is not persuasive because Bessette expressly teaches a composition comprising plant essential oils and an acceptable carrier, wherein the plant essential oil comprises a six member carbon ring

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and having substituted thereon at least one oxygenated functional group (see Column 3, lines 41-47). In Column 4, lines 10-15, Bessette teaches phenyl ethyl alcohol as a compound comprising the referenced composition, which is effective against mites (see Table 13 in Column 13, lines 35-43). The compositions taught by Bessette are in the form of a wettable powder, a waterproof dust, a shampoo, a gel, and an aerosol spray.

With regard to Claim 2, as phenyl ethyl alcohol is a compound comprising a monocyclic, carbocyclic ring structure having a six members and having substituted by at least one oxygenated functional moiety, the referenced composition claims the subject matter.

It is noted that the reference does not teach that the composition can be used in the manner instantly claimed, however, the intended use of the claimed composition does not patentably distinguish the composition, per se, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting.

The references of Zocchi and Bessette claim the subject matter.

Moreover, it is noted that Applicant would appear to allege criticality with regard to the claimed functional effect of the claimed composition for control of mold mites. However, there is not clear and convincing evidence of criticality now of record as each of the references teach compositions comprising the same or essentially the same amounts of phenyl ethyl alcohol in

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admixture with an acceptable carrier. Although, it would appear that Applicant has found another useful application for a composition comprising effective amounts of phenyl ethyl alcohol for the control of mold mites, at present, the claims fail to distinguish over the prior art compositions made of record. Therefore, the data is insufficient to overcome the instant rejection made under 35 U.S.C. 102.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and Claim 2 as amended and newly submitted Claim 8 remain/is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Friedman et al. (US 4,446,161). Newly applied as necessitated by amendment

Friedman teaches food product compositions comprising effective dose amounts of aromatic alcohols for the control of microbial growth including bacteria, molds and yeasts, and the growth and reproduction of mite infestation. Friedman expressly teaches that the level of aromatic alcohols comprising the composition is from about 0.15 to about 1.0%, or 0.15 to about 1.5%, or 0.75 to about 1.25%, or 0.1 to about 0.75%, or 0.75 to 1% based on the weight of the food and other physiologically parameters (see Column 6, lines 12-33). Aromatic alcohols, such as the claimed phenyl ethyl alcohol, can be used alone as the effective active agent in the

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compositions taught by Friedman. In Column 9, under "EXAMPLE 2", Friedman expressly teaches a composition comprising 2-phenylethanol or phenyl ethyl alcohol. See also "EXAMPLE 4", in Column 10. In Column 13, under "EXAMPLE 10", Friedman teaches anti-mite agent comprising benzyl alcohol which is effective in the control of mold mites or the gravid mites (*Tyrophagus putrescentise*). See also Column 13, lines 27-68 to Column 14, lines 1-2.

The claims are drawn to a composition for the control of mites comprising, in admixture with an acceptable carrier, at least phenyl ethyl alcohol, wherein the compound is miticidally effective against mold mites.

The cited reference discloses a composition which appears to be identical to the presently claimed composition (see Column 14, lines 41-55, wherein Friedman teaches a food product comprising 2-phenylethyl alcohol), since it comprises the same compound as disclosed in the invention of Applicant. Consequently, the claimed strain appears to be anticipated by the reference.

In the alternative, even if the claimed composition is not identical to the referenced composition with regard to some unidentified characteristics, the differences between that which is disclosed and that which is claimed are considered to be so slight that the referenced composition is likely to inherently possess the same characteristics of the claimed composition particularly in view of the similar chemical compound and the same effective dose amounts which they have been shown to share. Thus, the claimed composition would have been obvious to those of ordinary skill in the art within the meaning of USC 103.

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Moreover, it is noted that Friedman does not demonstrate that the referenced composition taught in "EXAMPLE 12" has the claimed functional effect for the control of mold mites.

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the benzyl alcohol for phenyl ethyl alcohol in the making of a composition with the claimed functional effect because Friedman expressly teaches that the aromatic alcohols of his invention have miticidal activity. At the time the invention was made, one of ordinary skill in the art would have been motivated and one would have had a reasonable expectation of success to substitute one aromatic alcohol the other in the making of a composition for the control of mites because Friedman teaches that aromatic alcohols, e.g., benzyl alcohol and phenyl ethyl alcohol, are effective against the infestation of mites such as the mold mite, *Tyrophagus putrescentiae*. Please note that when applicant claims a composition in terms of function and the composition of the prior art appears to be the same, the Examiner may make a rejection under both 35 U.S.C. 102 and 103, expressed as a 102/103 rejection (MPEP 2112).

As the reference indicates that the various proportions and amounts of the ingredients used in the claimed composition are result variables, they would have been routinely optimized by one of ordinary skill in the art in practicing the invention disclosed by each of the references.

Accordingly, the claimed invention as a whole was at least *prima facie* obvious, if not anticipated by the reference, especially in the absence of sufficient, clear, and convincing evidence to the contrary.

No claims are allowed.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

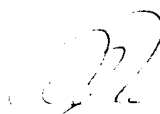
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Flood whose telephone number is (703) 308-9432. The examiner can normally be reached on Monday through Friday from 7:15 am to 3:45 pm. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703) 308-0196 or the Supervisory Patent Examiner, Michael Wityshyn whose telephone number is (703) 308-4743.

MCF

December 3, 2001



CHRISTOPHER R. TATE
PRIMARY EXAMINER